

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Double Patenting

The Examiner object to claims 1-15 as being provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending application no. 09/752,062.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention can be applied for both serial ATA device and parallel ATA device.

A terminal disclaimer are submitted with the current resposne.

35 U.S.C. § 112, second paragraph, Rejections

Examiner rejected claims 1, 2, 5, 6, 7, 12 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly pint out and distinctly claim the subject matter which applicant regards as the invention.

Claim Objections

The Examiner objected to claims 7, 8, and 12 because of the following informalities: the citation "a serial Advanced Technology Attachment (SATA)" does not have a clear meaning. For further examination, the Examiner considers SATA is SATA device.

Appropriate correction is have been made with the foregoing amendments.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,266,714 (hereinafter "Jacobs, et al.").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Independent claims 1, 7, 9, and 12 of the present application include limitations not disclosed or taught by Jacobs, et al. As a result, claims 1, 7, 9, and 12 are patentable over Jacobs, et al.

In particular, applicant's claims, as amended, include the limitation, or a limitation similar there to, of:

determining a first system Advanced Configuration and Power Interface Specification (ACPI) state, the ACPI states including a first power on state, a second power state, and a power off state, the second power state to consume less power than the first power state; and

switching a serial Advanced Technology Attachment (SATA) between two devices, the switching based upon the ACPI state. (Applicant's claim 1 as amended).

Jacobs, et al., however, does not disclose nor suggest the limitations as claimed by applicant. More specifically, Jacobs, et al. is limited to disclosing determining if a power switch of a computer is in either a off state or on state.

Therefore, in view of applicant's independent claims including limitations that are not disclosed nor suggested by Jacobs, et al., applicant's independent claims are patentable over Jacobs, et al.

In addition, the remaining claims depend from one of the independent claims as discussed above, and therefore include similar limitations, and as a result are also patentable over Jacobs, et al.

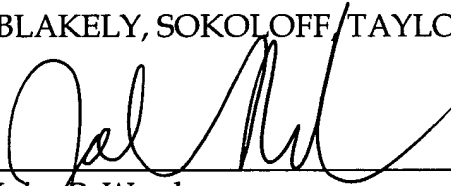
CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF TAYLOR & ZAFMAN

A handwritten signature in black ink, appearing to read 'John P. Ward', is written over a horizontal line.

Date: 01/27/2004

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